

**REMARKS**

Claims 1-19 are pending in the application. No claims have been amended, added or canceled. Thus, claims 1-19 remain subject to continued examination.

**ART REJECTIONS:**

Each of the independent claims (1, 10 and 19) stands rejected under 35 U.S.C. 103(a) as being obvious over the prior practice of using a label with one adhesive free end in view of either U.S. Patent 4,479,316 to Wipperfurth or U.S. Patent 2,095,437 to Fox. No other rejections have been applied to the independent claims. At this time Applicants respectfully traverse the outstanding rejection of the independent claims on grounds that the art relied upon in the Office Action does not establish the required *prima facie* case of obviousness. Thus, it is respectfully submitted that the independent claims and all claims depending therefrom stand in condition for allowance.

In order to establish a *prima facie* case of obviousness, the prior art references must teach or suggest all claim limitations. Moreover, there must be a reasonable expectation of success. MPEP §2143. The prior art must be considered in its entirety including portions that would lead away from the claimed invention. In addition, in a claim directed to a process, the materials on which a process is carried out must be accorded weight in determining patentability of the process. MPEP §2116. As best understood, Applicants respectfully submit that neither of the proposed combinations of art relied upon by the Office Action meets these standards with respect to the independent claims.

**COMBINATION I – USE OF LABELS WITH ONE ADHESIVE FREE END IN  
COMBINATION WITH WIPPERN**

As indicated in the attached Declaration of Joseph Egan, a fundamental consideration in the marking of a moving web is obtaining the secure attachment of the label to the moving material. If attachment is not sufficiently secure, the label is likely to be lost and a defect or other

reason for marking the web will also be lost. In recognition of the desire for a secure attachment, the prior practice utilized labels with a single adhesive free end thereby enhancing the adhesive contact area between the web and the label. Accordingly, the conventional thinking has been that substantial adhesive free interface zones between the web and the label are to be avoided. Thus, the practice according to the present invention wherein an adhesive free zone is disposed inboard of the web edge actually results in a reduction in the adhesive contact surface area which is contrary to the conventional wisdom in the art. In fact, the perceived need to avoid substantial adhesive-free interface zones was so ingrained that manufactures of label strips for moving webs have long produced "right handed" and "left handed" label strips in which the labels are oriented in reverse fashion from one another along supporting strips so as to ensure that the adhesive free zone projects out from the web edge while maintaining substantial adhesive contact inboard of the edge.

As best understood, the teachings in Wipperm do not appear adequate to motivate one of skill in the art to abandon the prior thinking and replace the label having a single adhesive free end with a label having two adhesive free ends. In this regard it is to be noted that the narrow layer of adhesive in Wipperm is actually located on the label carrier strip (1) and not on the label (2). In fact, the side of the label facing the carrier strip is actually treated with an adhesive repellent. Col. 2, lines 23-26. Thus, it appears that in Wipperm the entire label is adhesive free. Based upon this teaching it is respectfully submitted that modifying the label having a single adhesive-free end to a configuration as taught by Wipperm would have no reasonable expectation of yielding a functional label since no adhesive would be present for attachment to the web.

#### **COMBINATION II – USE OF LABELS WITH ONE ADHESIVE FREE END IN COMBINATION WITH FOX**

As indicated above, a fundamental consideration in the marking of a moving web is obtaining the secure attachment of the label to the moving material. As best understood, the teachings in Fox do not appear adequate to motivate one of skill in the art to abandon the prior

thinking and replace the label having a single adhesive free end with a label having two adhesive free ends.

As indicated in the Office Action, the labels in Fox have edge portions 11 which are adhesive free so as to enable a label to be separated from a protective backing. However, the edge portions are formed along narrow uncoated portions of the label strip and thus have a width which is even less than that of the uncoated portions. In addition, the labels in Fox are directed to use in making prices and the like and thus do not reflect the requirements for marking a moving web. Applicants respectfully submit that the fact that labels with adhesive free edges of substantially di minimus width may have been known for use in marking substantially stationary items would not have suggested to the skilled person the ability to abandon the accepted wisdom in the art of marking fast moving webs and utilize a label with adhesive free zones at both ends.

In view of the fact that the nature of the work piece (i.e. the moving web) must be considered in the pending process claims and that the recognized thinking in the art was that substantial adhesive contact was desirable for such web marking, it is submitted that the proposed redesign of the web marking label to have two adhesive free ends based on the fact that a prior label for stationary articles may have been known represents the application of an "obvious to try" standard and thus does not support the rejection.

Even if the art were to be combined in the manner proposed by the Office Action, there would have been no reasonable expectation of success. In this regard it is noted that Fox specifically teaches that the uncoated portions of the label are to be narrow. However, if the prior web marking label having one adhesive free end is replaced with the label of Fox having such narrow adhesive free edges, there could be no reasonable expectation of success in attaching the label along the moving edge of the web such that the portion of the label projecting outboard of the edge is substantially adhesive free. That is, due to the movement of the web, such narrow adhesive free zones would require an unreasonable degree of precision to avoid adhesive protrusion. While the width of the adhesive free zones could be increased, such a redesign is contrary to the teachings of Fox and more importantly would begin to reduce the adhesive

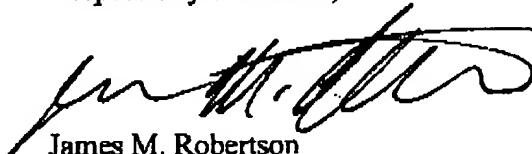
contact surface area between the web and the label. As previously indicated, such a reduction in adhesive contact surface area is contrary to the accepted wisdom in the field of label marking.

**CONCLUSION:**

For the reasons set forth above, it is respectfully submitted that all claims stand in condition for allowance. Prompt allowance and passage to issue is therefore requested. While Applicants have attempted to address all outstanding issues, in the event that any issue remains unresolved, the Examiner is encouraged to contact the undersigned attorney in the hope that such issue may be resolved in an expedient and satisfactory manner.

A petition for a two month extension of time accompanies this response. To any extent required, a petition for an additional extension of time is hereby made. Authorization is hereby provided to deduct any fee necessary for the acceptance of this paper from J.M. Robertson Intellectual Property Deposit Account 50-1424.

Respectfully submitted,



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